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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,473	11/02/2001	Xiaorong Wang	P00105US1A	5308

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/002,473	Applicant(s) WANG ET AL.	
	Examiner Katarzyna Wyrozebski Lee	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-17 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-17 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3, 7-17, 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the instant invention the applicants have amended the claims to read on styrene/ethylene/propylene/styrene elastomer. With respect to the above recitation, the examiner, while looking for support for the above limitation found following. The specification of the present invention recited (SEPS) however as a shortcut for styrene/ethylene/butene/styrene polymer, which is not what the applicants claim. Since the examiner is not capable predicting if such recitation is a typographical error or not, new matter rejection is issued. At the same time changing the styrene/ethylene/butene/styrene to actual styrene/ethylene/propylene/styrene will also be viewed as a new matter. The examiner noticed however, that as a preferred embodiment, the applicants have listed a tradename of SEPTON. If SEPTON is SEPS, the examiner will allow amendment to the specification with presentation of proper evidence, such as MSDS sheet or other printed publication that clearly indicates what SEPTON is.

For the time being since the new limitation is considered a new matter, the rejections of record are incorporated here by reference. Also, in the even that the applicants successfully overcome new matter rejection new prior art is also applied. As a result, this office action is final as necessitated by amendment.

Election/Restrictions

3. Claims 18 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group II and III respectively, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper dated 11/24/2003.

With respect to the applicants' statement of rejoinder of claim 19, as long as claim 19 contains all allowable subject matter of independent claim, it can be rejoined.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 1, 4-16 are rejected under 35 U.S.C. 102(e) as being anticipated by BRZOZOWSKI (US 6,300,418).

The discussion of the disclosure of the prior art of BRZOZOWSKI from paragraph 10 of the office action mailed on 8/19/2003 is incorporated here by reference.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 4-17, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over BRZOZOWSKI (US 6,300,418) in view of WANG (US 5,910,530).

The discussion of the disclosure of the prior art of BRZOZOWSKI from paragraph 10 of the office action mailed on 8/19/2003 is incorporated here by reference.

The difference between the present invention and the disclosure of BRZOZOWSKI is recitation of SEPS polymers instead of SEBS as well as extender oil and its amounts.

With respect to the above argument the prior art of WANG'530 discloses composition for gel derived from extending graft elastomers and polypropylene.

The elastomer in the disclosure of WANG'530 as listed in col. 2, lines 45-65 of this prior art include SEBS and SEPS. In view of the above the two polymers are capable of performing the same function in the composition and therefore are functional equivalent.

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The prior art of WANG also teaches use of extender oil (ABSTRACT) in the amount of at least 30 pbw. The specification (col. 9, lines 51-58) further discloses that the amounts of extender oil are in the range of 30-1000 pbw. The specification also teaches that the extenders of utilized include petroleum hydrocarbons such as aromatic and aliphatic hydrocarbons, which are oily at room temperature. Examples (6-9, col. 14) disclose aromatic oil as oil extender. Col. 9, line 2-3 further disclose naphtheic, aromatic, paraffinic and silicone oils.

Thermoplastic elastomers disclosed in WANG'530 which include both SEBS and SEPS are utilized because of its elastomeric properties and impact resistance. Extender oil and its amount added to the composition would influence the formation of gel.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize SEPS of WANG'530 in composition of BRZOZOWSKI along with the depicted amount of the extender oil and thereby obtain the present invention. Utilizing of SEPS in the composition of BRZOZOWSKI would still provide the composition with impact resistance while extender would still allow formation of gel.

8. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over BRZOZOWSKI (US 6,300,418) in view of WANG (US 5,994,468).

The discussion of the disclosure of the prior art of BRZOZOWSKI and WANG from paragraph 14 of the office action mailed on 8/19/20003 is incorporated here by reference. Newly added claims, are directed to the amount of the extender in the rubber composition, however, the prior art of WANG teaches the amounts claimed in newly added claims 20-23.

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In the amendment filed on 11/24/2003 the applicants have argued following:

a) The prior art of BRZOZOWSKI does not teach SEPS polymer.

With respect to the above argument, until new matter issue has been resolved this rejection will be maintained. If the new matter issue will be resolved the applicants have new rejection stated that addresses the amendment. In the new rejection the prior art of WANG'530 discloses use of SEPS and SEBS in oil-extended compositions as functional equivalents.

b) The applicants refer to the newly added claims 20 and stress the importance of criticality of the amount of extender oil.

With respect to the above argument, newly added claims are still rejected over the prior art of BRZOZOWSKI in view of WANG'468 as recited in the first office action on the merits, since the prior art of WANGE teaches the amounts required by the present invention. The newly added claims are also rejected by the new rejection of BRZOZOWSKI over WANG'530, which teaches the type of the extender and its amount that is required to make a gel composition.

c) The applicants argued that there is no motivation for one of ordinary skill in the art to obtain the present composition having desirable Shore A hardness as well as other corresponding properties.

With respect to the above argument, it is examiner's position that the motivation exists, especially since both prior art disclosures teach oil extenders of the same type. The oil extenders are utilized in composition comprising nylon and thermoplastic elastomer. In addition Shore A Hardness is one of the properties studied by both prior art disclosures.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

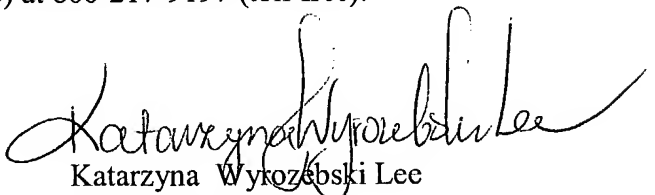
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Katarzyna Wykożebski Lee
Primary Examiner
Art Unit 1714

kiwl
March 3, 2004